

REMARKS

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

According to MPEP § 803:

“There are two criteria for a proper restriction requirement between patentably distinct inventions:

- (A) The inventions must be independent * * * or distinct * * *; and
- (B) There would be a serious burden on the examiner if restriction is not required * * *.”

The language of MPEP § 803 clearly indicates that a restriction requirement is improper and should not be made where there is *not* a serious burden on the examiner if restriction is not required.

The Examiner says “[t]here is an examination and search burden for these patentably distinct species [of claims 37 and 38] due to their mutually exclusive characteristics.” In response, Applicants respectfully disagree.

Applicants’ amendment of January 7, 2008, did not expand the Examiner’s examination burden. Instead, Applicants’ amendment *reduced* the Examiner’s examination burden.

Thus, Applicants’ amendment of January 7, 2008, *narrowed* step (a) of claim 9 to require that the CD4⁺CD25⁺ T cells were activated.

Claim 37 narrowed claim 9 further by requiring that the activated CD4⁺CD25⁺ T cells had been produced by subjecting unactivated CD4⁺CD25⁺ T cells to plate-bound anti-CD3 and soluble anti-CD28 antibodies.

Claim 38 likewise narrowed claim 9 by requiring that the activated CD4⁺CD25⁺ T cells had been produced by subjecting unactivated CD4⁺CD25⁺ T cells to mature dendritic cells.

When the Examiner issued the Office Action dated August 7, 2007, i.e., *before* Applicants' narrowing amendment of January 7, 2008, she necessarily examined all of the subject matter of present claims 9, 37 and 38 and more. Consequently, Applicants' amendment of January 7, 2008, did not necessitate this restriction requirement, nor is the restriction requirement justified by any examination burden occasioned on the Examiner by such amendment.

While the amendment of January 7, 2008, does require the Examiner to consider the effect of the term "activated" as introduced into claim 9, this is not a "serious burden" on the Examiner. It was stated throughout the instant specification, as discussed in the second paragraph on page 5 of the amendment of January 7, 2008, that the CD4⁺CD25⁺ T cells needed to be activated in order to anergize CD4⁺CD25⁻ T cells. Applicants' amendment to claim 9, thus, merely made explicit what was already implicit in the claim. Certainly, the amendment of claim 9 to recite "activated" was a move that the Examiner should have anticipated and, therefore, restriction is, again, improper.

Claims 37 and 38 depend on claim 9 and, therefore, incorporate all the limitations thereof and do not themselves expand the Examiner's search and examination of claim 9,

but, rather, are fully encompassed thereby. Accordingly, Applicants' introduction of claims 37 and 38 did not necessitate this restriction requirement.

Applicants respectfully submit that this restriction requirement, particularly coming at this late stage of the prosecution, wherein numerous substantive Office Actions have already been issued and responded to, is unjustified and, moreover, unfair and Applicants respectfully request that it be reconsidered and withdrawn. An early notice that the restriction requirement has been reconsidered and withdrawn is earnestly solicited.

If the restriction requirement will not be withdrawn, Applicants respectfully request rejoinder of claim 38 in the event claim 9 is allowed.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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